

### **REMARKS**

In the Office Action, claims 23-35 were rejected and claims 36 and 38 were indicated as withdrawn from consideration. By the present response, claim 23 is amended, and claim 30 is canceled. Upon entry of the amendments, claims 23-29, 31-35, 36, and 38 will be pending in the present patent application. Reconsideration and allowance of all pending claims are requested.

In the Office Action mailed on September 2, 2004, the Examiner indicated that claims 23-35 were rejected. However, as stated by the Examiner on page 2 of the Office Action, claim 35 was withdrawn prior to the issuance of the present Office Action, following a telephonic conversation with Examiner Nguyen. Thus, Applicants request the Examiner to remove the rejection of claim 35.

### **Specification**

Applicants respectfully submit that paragraphs [0030] and [0031] have been amended to overcome the minor deficiencies of missing words and incorrect reference numerals and to particularly point out the structure of the ground wall insulation tape.

### **Rejections Under 35 U.S.C. §102**

Claims 23-25 and 32 were rejected under 35 U.S.C. §102(b) as being anticipated by Japanese Patent 56-145,740. Further, claims 23, 24, and 32 were rejected as being anticipated by U.S. Patent 3,069,302, Lewis et al. (hereinafter "Lewis"). All of the claims are believed to be patentable for reasons summarized below.

### **Claim 23 and the Claims Depending Therefrom.**

By the present response, independent claim 23 is amended to particularly point out the structure of the ground wall insulation tape and distinctly claim the recited subject matter.

Amended claim 23 recites a method of manufacturing an article. The method includes disposing an electrically insulating backing upon a preformed winding of a magnet wire. A mica paper is disposed upon the electrically insulating backing. Polymeric resinous films are then disposed on top and bottom sides of the mica paper to form a ground wall insulation tape. Subsequently, a curable polymeric resin is disposed on the ground wall insulation tape.

By the present response claim 23 is amended to particularly point out the structure of ground wall insulation tape having two polymeric resinous films disposed on either side of the mica paper, which was not proposed in the art prior to invention. Advantageously, the polymeric resinous films employed in the ground wall insulation protection keeps mica paper from disintegrating at elevated temperatures. Moreover, the polymeric resinous films withstand high pressures during processing and therefore protect the mica tape from the ground wall insulation layer.

**The Japanese Patent reference fails to disclose polymeric resinous film in the insulation structure.**

As noted above, the Examiner relied upon the Japanese Patent (abstract of the Japanese Patent) for teaching insulated winding for a rotary machine (a rotor or stator). However, Applicants respectfully submit that Examiner has not addressed the elements recited in claim 23 with respect to the Japanese Patent. Accordingly, claim 23, as amended, is believed to clearly distinguish the recited method over the teachings of the Japanese Patent reference.

**Lewis fails to disclose polymeric resinous film in the insulation structure.**

In the rejection of independent claim 23, the Examiner stated that Lewis discloses forming an insulated conductor for a stator by applying a glass fiber tape to the same followed by the application of a mica tape. Regarding the recitations of claim 23, the Examiner referred to a passage found at col. 6, lines 5-24. The passage reads

[t]he coil 10 comprises four turns 12 of a conductor to which there has been applied turn insulation 13. The turn insulation 13 may comprise a mica tape or a glass tape, usually with a resin impregnant such, for example, as an epoxy resin or a thermosettable polysiloxane resin. The turns of the conductors 12 are then wrapped with plies of the mica tape 14 comprising a sheet backing 16, a layer of mica flakes 18 and a covering sheet 20, all united with the viscous polysiloxane composition of a viscosity of from 100 to 100,000 poises at 25°C.

Thus, Lewis teaches applying a mica sheet on a sheet backing and applying a covering sheet on the mica sheet. However, Lewis does not teach application of a polymeric resinous film on either side of the mica sheet.

For the reasons summarized above, Applicants respectfully submit that a *prima facie* case of anticipation has not been established. Therefore, it is submitted that independent claim 23 is allowable and respectfully request the Examiner to reconsider rejection of the claims.

With regard to dependent claims 24-29, and 31-34 these claims depend directly or indirectly from allowable claim 23, and are therefore considered to be equally allowable.

#### **Rejections Under 35 U.S.C. §103**

Claims 23-28 and 32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent 56-145,740 in view of U.S. Patent 2,479,417, Schulman et al. (hereinafter "Schulman"). Claims 29-31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent 56-145,740 in view of U.S. Patent 3,254,150, Rogers et al. (hereinafter "Rogers"). By the present response claim 30 is canceled. Claims 32-34 were rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent 56-145,740 in view of Lewis.

In the rejection of independent claim 23, the Examiner acknowledged that the Japanese Patent fails to teach a mica tape having a binder therein, wherein the binder is an adhesive. The Japanese Patent teaches a method for forming an insulate winding for a rotary machine (a rotor or stator) by winding a heat resistant insulating tape or glass fibre about the windings. Following the application of the heat resistant insulating tape, the reference suggests that one apply a heat resistant porous insulating tape consisting of composite mica material about the electrically insulating backing material of a glass fibre. The reference suggests that the assembly should be coated with a solventless polyimide resin and that the final assembly was cured. Further, the Examiner points out that Schulman discloses the use of a mica composite tape, which included an adhesive therein.

Applicants respectfully submit that there is no suggestion in the Japanese Patent or Schulman that would have motivated an ordinary skilled artisan to modify the arrangement of the Japanese Patent or Schulman to include two polymeric resinous films disposed on either side of the mica paper to produce ground wall insulation in motors.

Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established for the independent claim 23.

In response to the rejection of claims depending from claim 23, it is respectfully submitted that insomuch as independent claim 23 is allowable, claims 24-29 and 31-34 are allowable at least by virtue of their dependence from an allowable base claim.

### **Conclusion**

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a

telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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